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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/502,701

Filing Date: February 11, 2000

Appellant(s): FOX, PHILIP F.

MAIL FD

AUG 05 2004

GROUP 3600

Philip Fox
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed Sept 25, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 6, 7, 9, 26, 27 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 2 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 3 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 4 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 5 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 6 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 7 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 8 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 24 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 25 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 28 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 29 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claims 10-13, 17-18 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 14 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 15 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 16 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claims 19 and 22 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 20 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 21 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 39 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 40 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 23 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 41 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 42 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 30 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 31 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 32 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 33 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 34 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 35 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 36 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 37 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 38 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 43 stands alone and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Art Unit: 3643

4827658	Wolniak	5/1989
5131179	McEwen	7/1992
4311262	Morin	1/1982

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-2, 7-9, 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Thibodeaux. This rejection is set forth in a prior Office Action, mailed on 3/25/2003.

Claims 10-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolniak. This rejection is set forth in a prior Office Action, mailed on 3/25/2003.

Claims 19, 21, 22-23, 39, 41 are rejected under 35 U.S.C. 102(b) as being anticipated by McEwen. This rejection is set forth in a prior Office Action, mailed on 3/25/2003.

Claim 3 is rejected under 35 U.S.C. 103 as being obvious in view of Morin. This rejection is set forth in a prior Office Action, mailed on 3/25/2003.

Claims 27-29 are rejected under 35 U.S.C. 103 as being obvious in view of Thibodeaux. This rejection is set forth in a prior Office Action, mailed on 3/25/203.

Claims 1, 4-6, 16, 43 are rejected under 35 U.S.C. 103 as being obvious over Wolniak in view of Thibodeaux. This rejection is set forth in a prior Office Action, mailed on 3/25/2003.

Claim 20 is rejected under 35 U.S.C. 103 as being obvious over McEwen. This rejection is set forth in a prior Office Action, mailed on 3/25/2003.

Claims 35-36 are rejected under 35 U.S.C. 103 as being obvious over Wolniak . This rejection is set forth in a prior Office Action, mailed on 3/25/2003.

Claims 40 and 42 are rejected under 35 U.S.C. 103 as being obvious over McEwen in view of Wolniak . This rejection is set forth in a prior Office Action, mailed on 3/25/2003.

(11) Response to Argument

Applicant argues that the examiner has mischaracterized Thibodeaux, but that is not the case as the examiner has merely used broadest reasonable interpretation such as that the elements 12-14 of Thibodeaux can be considered as extendable elongate shells that are located adjacent to each other as shown in Fig. 1 noting that no frame of reference is stated. Also see Fig. 4. The claims of the present invention do not require that the interior surface that defines an elongate cavity is continuous. Clearly Thibodeaux shows a tube structure in Fig. 4. In regard to claim 2, applicant argues that the bore of Thibodeaux does not extend through the top surface 5. however, the top surface can be considered to be very thin and hence, the tubes of Thibodeaux would extend through the top surface. The tubes of Thibodeaux are interlocked together by U-shaped grooves and protrusions and since a tube is shown in Fig. 1 mounted in the top surface, it can safely be assumed that members 12 do not slip through the bore.

Applicant keeps insisting that the cup members of Thibodeaux can not be considered as tubes, but they certainly look like tubes in Fig. 4. Also, tubes can have closed ends like the test tubes used in chemistry labs. Since the tubes slide in one another they can be considered as male/ female tubes which can be lengthened or shortened. See the

description in column 2, lines 35-49. In regard to claim 10, Applicant has not stated what the length that is adequate to accept a portion of an ice fishing rod. Applicant argues at length that Wolniak is for fishing lures not ice fishing rods, but provides no factual data as to what length of rod is to be stored. As to the recess in the bottom of the container of Wolniak, the area under the holes 23 is a recess. Part of the tube 30 can be considered as an elongate shell and part of the tube can be considered a socket. In reference to claim 30, this claim does not require a cover or that the cover is closed. Hence the fishing rods can be stored in to the tubes 30 of Wolniak when the cover is open such as in a fishing location. The rods would then be removed when it was time to close the tackle box. In reference to claim 31, Wolniak shows structure capable of performing the intended use. In reference to claim 34, Wolniak shows an ice fishing tackle storage system having a pair of shells 30, 30A, each of the shells has an interior surface that defines an elongated cavity and ice fishing tackle such as the fishing lure shown in Fig. 3. Wolniak shows a first spacing component 22 and the elongate shells are each secured by the first spacing component. Wolniak shows a first wall such as a side wall attached to the first spacing component. Wolniak shows a container 10 with a first wall 12 and a second wall 13 with the elongate shells and spacing component positioned in the container as shown in Fig. 1. The first wall and the second wall define a chamber within the container that contains the elongate shells. An ice fishing tip-up is capable of being placed in one of the elongate shells which is in the container. Also, an ice fishing tip-up can be placed between the rows of elongate shells or in the top or closure portion 20 which makes up part of the container. Hence

Wolniak shows each and every feature recited in claims 30-34. In reference to claim 37, Wolniak shows the elongate shells and the first spacing component as discussed in reference to claim 34. Wolniak shows a second spacing component 21 located in the bottom of the container 10 below the first spacing component 22 as shown in Fig. 2. the spacing components are spaced apart from each other. Wolniak shows the container 10 having a closed bottom 13 and an open top just below rim 14. the first spacing component 22 is positioned at the open upper end just below the rim 14 as shown in Fig. 2. In reference to claim 25, Thibodeaux shows a stacked structure of cups that make up a tube.

The cups can be added to or subtracted from so the tube can be selectively and reversibly capable of being lengthened or shortened and hence, the elongate cavity too can be lengthened or shortened. In reference to claims 27-29, elements 13-14 of Thibodeaux can be considered as stops since they stop the rotation between the concentric cup members 12. the frictional forces between the groove and the protrusion also, inherently act to hold the cups in an extended position or a selected level of extension. As to McEwen and claim 19, inherently the tubes help support the entire apparatus since they are in contact with the ground. Note the use of the open ended term "comprising". Further applicant has not been able to give any evidence as to how much support is given by the relative elements. The legs 40, 42 of McEwen can also be considered as part of the elongate shells and also function as legs that are in contact with the ground that contribute to stably support the apparatus on a surface. The spacing structure effective to prevent slippage of the at least two elongate

shells with respect to the spacing structure. Hence McEwen does show all of the elements recited in claim 19. In reference to claim 23, McEwen shows tubes 16, 18 and legs 40, 42 that contribute to the support of the entire apparatus. As to the statement that absent water in the bucket that insufficient stability would exist. McEwen states in column 4, lines 42-44 that because the bucket is partially filled with water the fishing poles will be steady. This does not state that the bucket will fall over if there is not water in the bucket, merely that the poles will be steady. This is clearly different than the bucket not being stable and falling over.

In regard to claim 3, applicant argues that a *prima facie* case for obviousness has not been established. However, one skilled in the art would see the benefits from supporting the fishing rod in two places and that would be that a more stable support would be an advantage in holding a long fishing rod. As to the hindsight reconstruction, it should be pointed out that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill in art at the time the invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971). Further, the additional template would support the cups of Thibodeaux, but it is not clear how this modification would open the cooler to the atmosphere as applicant contends. In regards to claims 27-29, applicant argues that Thibodeaux even if the stops recited were adjustable that the results would not yield the claimed invention because the stops are to prevent rotation and not elongation of

the cups. However, as stated above, the stops inherently have a frictional force between them which also acts to hold the cups in longitudinal alignment. However, since the Applicant also argues that there is no way that the line could come into contact with the sides of the receptacle. However, this is also incorrect since if the pole is inserted tip end down into the cup, then the line will come into contact with the walls and top edge of the receptacle. Applicant also traverses that rounded surfaces old and well known in the art. The board is invited to see Des 261, 581 notably Fig. 6 which shows rounded surfaces to ease rod insertion and also to protect the line against abrasion are old and well known in the art.

In regard to claims 1 and 4, 16 as rejected by Wolniak in view of Thibodeaux, applicant argues on page 55 that the nesting cup members of Wolniak (Thibodeaux) would not even if inserted into the tubes of 30 of Wolniak define an elongate cavity. The tube Applicant further argues that the cover portions 20a and 20b would not close which would destroy an important and intended function. One skilled in the art of fishing would design the tackle box to be closed when employing an adjustable length tube by either having the extended tube length be less than the height of the tackle box or the collapsed length of the tube be shorter than the height of the tackle box. Wolniak shows walls 12, 13 and also partitions 21, 22 act as interior walls. These walls have a plurality of apertures through which the tubes 30 pass. The wall 22 acts as a top wall as shown in Fig. 2. Applicant has submitted no evidence as to why apertures in the walls 21, 22 of Wolniak can not be considered as sockets noting that sockets hold long tubular members such as bolts and the apertures in Wolniak hold tubes. Also, sockets

such as wall sockets hold the prongs of a plug which are plugged in to the socket. Thus the apertures in walls 21, 22 can be considered as sockets. In reference to claim 43, Wolniak shows a tackle box having a plurality of elongate shells with a first spacing component. Thibodeaux is cited to show a bucket since it is a cooler it is intended to hold ice and or water. It would have been obvious to provide Wolniak with a bucket as shown by Thibodeaux since merely one container is being substituted for another and the function is the same.

In regard to claim 20 as rejected under McEwen it should be pointed out that the disassembly of McEwen is not precluded by any of the previous claims and that disassembly of the tubes 16 and 18 and storing them in the bucket would merely be employed to store the apparatus in a smaller area when not being used.

In regard to Wolniak in reference to claims 35-36, the chamber is the area on the inside of the tackle box and it would have been obvious to round the top surface for ease of insertion. It should be pointed out that applicant does not claim storing fishing rods or tip-ups. Claim 36 recites storing ice fishing tackle which the lure shown in Fig. 3 of Wolniak is. Again, as stated above, the Des 261, 581 patent shows rounding the top surface of the tube as shown in Fig. 6.

In regard to claims 40 and 42, applicant argues that moving the storage template of Wolniak into the container of McEwen would hinder the storage of water in the container, but this is not seen to be the case since McEwen states that the container is only partially filled with water in column 4, lines 42-44. hence, the combination proposed would locate the template on an upper part of the bucket above the water

level so that not only could live bait be stored in the bucket, also fishing tackle as well.

It is not seen how employing hollow tubes with the foam template of Wolniak could cause the bucket of McEwen, now partially filled with water to become unstabilized. The combination would have the top parts of the tubes from Wolniak extending above the top of the McEwen bucket to provide access.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Kurt Rowan
Primary Examiner
Art Unit 3643

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August 2, 2004

Conferees:

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